

REMARKS

Applicant respectfully requests reconsideration and allowance of claims 1-44, which stand rejected in the above-identified application. In view of the following discussion, Applicant submits that all pending claims are in condition for allowance.

In the Office Action (OA) at page 2, the Examiner rejects claims 1-5, 11-17, 19-25, and 39-44 under 35 U.S.C. §102(e) as being anticipated by U.S. Pub. No. 2005/0105508 to Saha (hereinafter “Saha”). On page 18, the Examiner rejects claims 6 and 26 under 35 U.S.C. § 103 (a) as being obvious over Saha. On page 19, the Examiner rejects claims 7-10, 18, 27-30, and 38 under 35 U.S.C. §103(a) as being unpatentable over Saha in view of U.S. Pub. No. 2003/0107991 to Tezuka et al. Applicant respectfully traverses this rejection.

Applicant hereby incorporates herein the remarks from Applicant’s responses of January 31, 2008 and June 30, 2008. Applicant has previously submitted a Declaration and supplemental evidence to swear behind the Saha reference under 37 C.F.R § 1.131. Because the disclosure activity associated with the Rule 1.131 affidavit predates the Saha reference, and the above rejections all depend upon the availability of Saha as a reference against the pending claims, and because the Applicant continues to assert the validity of the Rule 131 affidavit, this response does not include remarks in support of the patentability of the pending claims over the above-cited rejections. Instead this response is directed to the “Response to Affidavit” section of the OA.

The Declaration and Supporting Evidence Establish Conception of the Invention

In the response filed June 30, 2008, the applicant provided documentation and remarks in support of the required showing under 37 C.F.R. § 1.131 (b). Specifically, Applicant asserted the existence of conception prior to the effective date of the Saha reference coupled with due diligence from prior to said date to the filing date of the present application.

In response to the foregoing, the Examiner (on pages 24-25 of the OA) addresses only the sufficiency of the disclosure information in the materials provided by Applicant to show conception. Accordingly, Applicant presumes that the other issues are not in dispute, and addresses below only the issue of the sufficiency of the disclosure information associated with the Rule 131 affidavit.

To complete conception, “the invention must be ready for patenting . . . by proof that prior to the critical date the inventor had prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.” See *Pfaff v. Wells Elecs.*, 525 U.S. 55, 119 S. Ct. 304, 312, 48 U.S.P.Q.2d 1641, 1647 (1998); and M.P.E.P. § 706.02 (L)(2). Further, Applicant notes that the disclosure of a single species is sufficient to antedate a reference and to support a generic claim under 37 C.F.R. § 1.131. See *Ex Parte Biesecker*, 144 USPQ 129, 130 (Bd. App. 1964); and M.P.E.P. § 715.03 (II). Applicant contends that the disclosure information included with the affidavit discloses a species of the invention sufficiently to enable one having skill in the art to practice the invention. Applicant elaborates below.

On page 24, the Office Action recites the requirements for conception, citing to *Mergenthaler v. Scudder* 11 App. D.C. 264, 81 O.G. 1417, 1897 C.D. 724 (D.C. Cir. 1897). The Examiner alleges only one deficiency in Applicant’s affidavit and supporting evidence, reciting that “[t]he declaration does not contain sufficient evidence to support the concept of the invention.” Applicant respectfully disagrees and elaborates below. Below, reference is made to a six-page document accompanying the “Declaration” document submitted on June 30, 2008. This six-page document is referred to herein as the “affidavit disclosure document”. While page numbers are not listed on all pages of the affidavit disclosure document, Applicant is proceeding on the assumption that the pertinent pages and passages of this document can be readily accessed by the Examiner.

For the sake of brevity, the pertinent claims are not repeated in their entirety herein. However, in the following, the limitations of claim 6 (and of the claims in the chain of dependency of claim 6) are briefly reviewed and then compared to the disclosure information on page 5 of the affidavit disclosure document.

Claim 1 is an independent claim forming part of a claim set in which claim 3 depends from claim 1, and in which claim 6 depends from claim 3. Claim 1 is directed to a method in which information is obtained for a Voice-Over-Internet call coupled between one or more packet switched networks and one or more public switched telephone networks, in which calls are gathered at one or more session controllers. The calls are analyzed to check for inactivity, and the session controller drops calls deemed to be inactive. Claim 3 qualifies the analyzing step to include checking for an uptime values for the calls exceeds a threshold level. And, claim 6 further qualifies claim 3 to establish a threshold level of 180 minutes.

The disclosure information in paragraph 5 of page 5 of the affidavit disclosure document recites that “ITXC constructs an applications that runs the specific command . . . every 5 minutes, measuring the call id’s and uptime values for each id. Any call that is over the set time limit (180 min) will be released from the Session Controller . . .” (emphasis added). Numbered section 2 on page 4 of the affidavit disclosure document discusses current implementations and indicates that the context of the discussion contemplates “VOIP Session controllers”.

Applicant respectfully contends that the subject matter of the species recited in claim 6 of the current application is clearly disclosed in the language quoted from the affidavit disclosure document. Although slight variations in language exist between the affidavit document and the claims, it is clear that the affidavit disclosure document describes measuring (see the “obtaining” and “analyzing” steps of claim 1 and the “determining” step of claim 3) the uptime values of the calls and having the session controller release (claim 1’s dropping step) calls that are over the set time limit of 180 minutes (i.e. *threshold level of 180 minutes* of claim 6).

Based on the foregoing, Applicant contends that the disclosure information in the affidavit disclosure document would readily enable a person of skill in the art to practice the invention recited in claim 6. And, since a generic claim is sustained by the disclosure of a single species of the genus of the generic claim (see *Ex Parte Biesecker*, 144 USPQ 129, 130 (Bd. App. 1964); and M.P.E.P. § 715.03 (II)), Applicant contends that the above-referenced disclosure information supports claim 1 in addition to supporting claim 6. Thus, the support for claim 1 antedates the Saha reference. Applicant contends that the other independent claims are supported for the same reasons as claim 1, and that all of the independent claims therefore antedate the Saha reference.

Since the independent claims are rejected under 35 U.S.C. § 102 only over the Saha reference (which has been antedated as shown above), it follows that the outstanding rejections have been overcome, and that the independent claims are patentable over the prior art. Moreover, the dependent claims are patentable over the prior art by virtue of their dependency on their respective independent claims. Based on the foregoing, all pending claims are allowable.

Conclusion:

As such, Applicant submits that the requirements set forth in 37 C.F.R. § 1.131 and MPEP §§ 715.02 have been met. Accordingly, Applicant respectfully requests that the Examiner's 35 U.S.C. §§ 102(e) and §103(a) rejections be withdrawn.

Applicant therefore respectfully requests reconsideration and allowance in view of the above remarks and amendments. It is not believed that any fees are due. However, in the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 50-4711.

Dated: March 24, 2009

Respectfully submitted,

By: s/Leslie S. Garmaise/
Leslie S. Garmaise, Reg. No. 47,587
KAPLAN GILMAN & PERGAMENT LLP
1480 Route 9 North, Suite 204
Woodbridge, New Jersey 07095
732-636-4500
Attorneys for Applicant